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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,055	07/21/2003	Anand Huprikar	12168	5934

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EXAMINER

WILLIAMS, THOMAS J

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JE

Office Action Summary	Application No.	Applicant(s)	
	10/624,055	HUPRIKAR, ANAND	
	Examiner	Art Unit	
	Thomas J. Williams	3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-23 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-23 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Acknowledgment is made in the receipt of the information disclosure statement filed July 12, 2004 and the amendment filed November 15, 2004.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6, 7, 9-11, and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2-309028 to Suzuki.

Re-claim 1, Suzuki discloses a mount assembly, comprising: a support structure 10 with an aperture (note 10a); a carrier 20/24 is mounted in the aperture; an insulator 16 is disposed between the support structure and the carrier; the insulator has a first portion 50 with a first resistance and a first maximum width, and a second portion 34 defining a second resistance and a second maximum width, the second resistance will be greater than the first resistance (due in part to the in series compression stage design), the second width is greater than the first width, the second portion is defined by a ledge; the carrier defines a cup 24 that surrounds the first portion and compresses the first portion without the compressing the ledge, the cup includes a flange spaced from the ledge during the application of the first force and engaging the compressing against the ledge during the application of the second force.

Re-claims 2-4, the first portion is partially compressed before the second portion is partially compressed, the first and second portions are the same material and are formed of a common homogenous material.

Re-claims 6, 7, 9-11 and 13, see figure 1.

Re-claims 14 and 15, the cup includes an inner wall 20 that extends through the aperture.

Re-claim 16, a plate 20 or 26 is mounted to a distal end of the wall.

Re-claim 17, a fastener 28/32 interconnects the plate with the inner wall.

Re-claims 18 and 19, portion 36 is interpreted as a second insulator, portion 36 is disposed between the plate 26 and the support structure 10.

4. Claims 1-3, 7, 9, 10, and 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,502,883 to Rice.

Re-claim 1, Rice discloses in figure 2 a mount assembly, comprising: a support structure 28' having an aperture; a carrier 48' is mounted in the aperture; an insulator 46 is disposed between the support structure and the carrier; the insulator has a first portion 46b with a first resistance and a first maximum width, and a second portion 46b defining a second resistance and a second maximum width, the second resistance will be greater than the first resistance (due in part to the in series compression stage design), the second width is greater than the first width, the second portion is defined by a ledge (note portion closest to the first portion that is spaced from the carrier); the carrier defines a cup 44' that surrounds the first portion and compresses the first portion without compressing the ledge, the cup includes a flange (portion parallel to the

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ledge) spaced from the ledge during the application of the first force and engaging the compressing against the ledge during the application of the second force.

Re-claims 2, 3, 7, 9, 10, 13-15, see figure 2, the cup may be defined as the beginning angled portion of 48'.

Re-claim 16, a plate 66 is mounted at a distal end of the inner wall of the carrier 48'.

Re-claim 17, a fastener similar to 32 (not illustrated) connects the carrier and the plate.

Re-claims 18 and 19, a second insulator 42 further couples the carrier and support structure, the second insulator is disposed between the support structure and the plate.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 20-23 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of US 5,743,547 to Voss et al.

Re-claim 5, Suzuki fails to teach the insulator formed from a micro-cellular polyurethane. Voss et al. teaches the increasing use of micro-cellular polyurethane when forming elastomeric springs or insulators. Voss et al. teaches that this material has high energy storage per weight, see column 7 lines 21-23. It would have been obvious to one of ordinary skill in the art to have manufactured the insulator of Suzuki from a micro-cellular polyurethane as taught by Voss et al, thus providing the mount with a light weight yet efficient spring element.

Re-claim 20, Suzuki teaches the mount as recited, see above paragraph 3. However, Suzuki fails to teach the insulator formed from a micro-cellular polyurethane and the height of the first portion relative to the second portion of the insulator, specifically the height of the first portion being at least 3 times larger than the height of the second portion.

Voss et al. teaches the increasing use of micro-cellular polyurethane when forming elastomeric springs or insulators. Voss et al. teaches that this material has high energy storage per weight, see column 7 lines 21-23. It would have been obvious to one of ordinary skill in the art to have manufactured the insulator of Suzuki from a micro-cellular polyurethane as taught by Voss et al, thus providing the mount with a light weight yet efficient spring element.

Regarding the differences in relative heights of the first and second portion. It would have been obvious to one of ordinary skill in the art as a matter of design choice through routine experimentation to have provided the first portion of Suzuki with a height difference of at least three times that of the second portion, since applicant has not disclosed that the recited height difference solves any stated problem or is for any particular purpose, and it appears that the insulator of Suzuki would have performed equally well with a variety of height differences between the first and second portion, just as in the instant invention.

Furthermore, the courts have ruled that changes in shape or configuration are obvious absent persuasive evidence, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In addition the instant disclosure clearly states on page 6 paragraph 25 that the differences in heights between the first and second portions can vary depending upon the desired application. As such it appears that the recited height difference is not of particular importance.

Re-claims 21-23 and 28-30, see figure 1.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki.

Re-claim 8, Suzuki fails to specify the height of the first portion relative to the second portion, and more specifically that the height of the first portion is at least 3 times larger than the height of the second portion. It would have been obvious to one of ordinary skill in the art as a matter of design choice through routine experimentation to have provided the first portion of Suzuki with a height difference of at least three (3) times that of the second portion, since applicant has not disclosed that the recited height difference solves any stated problem or is for any particular purpose, and it appears that the insulator of Suzuki would have performed equally well with a variety of height differences between the first and second portion, just as in the instant invention.

Furthermore, the courts have ruled that changes in shape or configuration are obvious absent persuasive evidence, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In addition the instant disclosure clearly states on page 6 paragraph 25 that the differences in heights between the first and second portions can vary depending upon the desired application. As such it appears that the recited height difference is not of particular importance.

Response to Arguments

8. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Inuzuka teaches a mount having the recited features.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is (703) 305-1346 (after April 2005 the new telephone number will be 571-272-7128). The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci, can be reached at (703) 308-3668 (after April 2005 the new telephone

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number will be 571-272-7099). The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

TJW

February 4, 2005

THOMAS WILLIAMS
PATENT EXAMINER

Thomas Williams
AU 3683
2-4-05